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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,416	02/14/2006	Seiichi Murakami	060118	7562
23850 7590 05/14/2009 KRATZ, QUINTOS & HANSON, LLP 1420 K Street, N.W. Suite 400 WASHINGTON, DC 20005				
EXAMINER				
MORRIS, JOHN J				
ART UNIT		PAPER NUMBER		
2629				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/568,416

Applicant(s)

MURAKAMI, SEIICHI

Examiner

John Morris

Art Unit

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/302)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claim 1-9 have been considered but are moot in view of the new ground(s) of rejection.

In regards to claim 1 the applicant argues that the examiner does not reference to any holding members that are U-shaped, the examiner agrees that the holding members are not U-shaped; however the limitation that the holding members must be U shaped is not in the claim. The applicant argues that the conductive paste conductive paste is not conductive and is fact an insulator; the examiner respectfully disagrees. The electrodes make electrical contact with the conductive paste. Paragraph 108 state that the conductive paste is silver paste and it is well known for silver paste to be a conductor. The applicant also argues that the paste cannot "hold" the peripheral edges of the transparent substrate, the examiner respectfully disagrees. The property of paste is to hold two things together and the fact that the paste is in between the two surfaces does not exclude it from holding the edges together, this is obvious by the fact that the edges are held together with the paste and without the paste the edges would not be held together. The applicant also argues that the reference does not teach lead out terminals, the examiner respectfully disagrees. Furuhashi teaches lead-out terminals in figure 2, items 11a, 11c, and 12.

The applicant argues that Furuhashi shows a notch corresponding to the AAPA notch; however, the applicant does not give a reason why the rejection is traversed; however, the argument is moot upon new grounds of rejection.

The applicant's argument in regards to claim 4 is also moot upon new grounds of rejection.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 3, 5, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Furuhashi et al. (US Pub# 20020000979 A1/ or "*Furuhashi*" hereinafter).

For **claim 1**, Furuhashi teaches a transparent first substrate and a second substrate each having a transparent electro-conductive layer on one surface thereof, the transparent first substrate and the second substrate being arranged with a predetermined interval between each other in such a manner that the transparent electro-conductive layers are facing each other, and each transparent electro-conductive layer including a respective pair of electrodes disposed on each end (Furuhashi, page 5 paragraph [0101] - page 6 paragraph[0112], figure 2). Furuhashi also teaches a plurality of lead-out terminals being connected to the electrodes through surrounding circuits extending to the peripheral edges of the first substrate and the second substrate, the lead-out terminals each being arranged on the opposing surfaces of the first substrate and the second substrate

(Furuhashi, page 5 paragraph [0101] - page 6 paragraph[0112], figure 2). Furuhashi teaches a plurality of holding members in direct contact with at least one peripheral edge for holding the peripheral edges of the transparent first substrate, the holding members being formed of an electro-conductive material and formed so that each of the portions inserted between the transparent first substrate and the second substrate is in contact with at least on respective lead-out terminal of either the first or second substrate (Furuhashi, page 5 paragraph [0101] - page 6 paragraph [0112], figure 2 items 8, 1, 2, 11a, 11c, and 12).

For **claim 2**, configuring the thickness of the portions of the holding members inserted between the transparent first substrate and the second substrate to 0.5 to 2 times the space between the transparent first substrate and the second substrate is an obvious matter of design choice. This is so because such a modification would only require a mere change of components. Furuhashi teaches adhesive material between the two substrates (Furuhashi, figure 2); this material could easily be modified to increase or decrease the space between. Furuhashi also teaches spacers in between the substrates to prevent the two substrates from touching each other (Furuhashi, figure 2); these spacers can also be configured to increase or decrease the space between the substrates.

For **claim 3**, Furuhashi teaches a notched portion that is contact with the holding members (Furuhashi, figure 2, items 8c).

For **claim 5**, Furuhashi teaches the first substrate as a fixed substrate (Furuhashi, figure 2, page 8, paragraph [0139]).

For **claim 6**, Furuhashi teaches a transparent first substrate and a second substrate each having a transparent electro-conductive layer on one surface thereof, the transparent first substrate and the second substrate being arranged with a predetermined interval between each other in such a manner that the transparent electro-conductive layers are facing each other, and each transparent electro-conductive layer having a pair of electrodes disposed on each end (Furuhashi, page 5 paragraph [0101] - page 6 paragraph[0112], figure 2). Furuhashi also teaches a plurality of lead-out terminals being connected to the electrodes through surrounding circuits formed on the peripheral edges of the first substrate and the second substrate, the lead-out terminals each being arranged on the opposing surfaces of the first substrate and the second substrate (Furuhashi, page 5 paragraph [0101] - page 6 paragraph[0112], figure 2). Furuhashi teaches a plurality of holding members for holding the peripheral edges of the transparent first substrate, the holding members being formed of an electro-conductive material and formed so that each of the portions inserted between the transparent first substrate and the second substrate is in direct contact with each lead-out terminal whereby the apparatus and the lead-out terminals are electrically coupled (Furuhashi, page 5 paragraph [0101] - page 6 paragraph [0112], figure 2). Furuhashi also teaches that this touch panel being disposed on the display surface side of the display apparatus, and the holding members being in contact with the connecting terminals (Furuhashi, figure 1).

For **claim 7**, Furuhashi teaches the holding members hold at least on eperipheral edge of the transparent first substrate (Furuhashi, figure 2, items 8, 1, and 2).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 4, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furuhashi et al. (US Pub# 20020000979 A1/ or "*Furuhashi*" *hereinafter*) in view of Takashi (JP- 2000187237).
- 5.

For **claim 4**, Furuhashi does not teach groove portions in the surface of the substrate; however, in the same field of endeavor, Takashi teaches holding plates to hold the substrates together (Takashi, abstract). Takashi does not teach grooves to hold the U-shaped holding members in place; however, the examiner takes official notice that it is well known in the art at the time of the invention to have grooves for holding members to be placed in. It would have been obvious to one skill in the art at the time of the

invention to modify Furuhashi with Takashi because both are touch panels and using the holding members provide a more secure way to hold the substrates together.

For **claim 8**, Furuhashi does not teach a U-shaped holding member; however, in the same field of endeavor, Takashi teaches a U-shaped holding member and an interior of the U overlaps the at least one peripheral edge of the transparent first substrate (Takashi, abstract). It would have been obvious to one skill in the art at the time of the invention to modify Furuhashi with Takashi because both are touch panels and using the holding members provide a more secure way to hold the substrates together

For **claim 9**, Takashi teaches U-shaped holding members, where the interior of the U overlaps the at least one peripheral edge and the connecting terminals are in direct contact with a leg of the U-shape (Takashi, abstract). It would have been obvious to one skill in the art at the time of the invention to modify Furuhashi with Takashi because both are touch panels and using the holding members provide a more secure way to hold the substrates together

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nakayama et al. (US Pat# 7227537 B2) discloses a touch panel; Takashi (Document # jp-2000187237) discloses a liquid crystal display device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Morris whose telephone number is (571)270-7171. The examiner can normally be reached on Monday-Friday, 7am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amr Awad can be reached on 571-272-7764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Amr Awad/
Supervisory Patent Examiner, Art Unit 2629